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| 09/551,302      | 04/18/2000  | Shlomo Touboul       | 40492.00012         | 1958             |

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EXAMINER

LE, DIEU MINH T

ART UNIT PAPER NUMBER

2184

DATE MAILED: 03/12/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Handwritten signature

# Office Action Summary

Application No.

09/551,302

Applicant(s)

SHLOMO TOUBOVL

Examiner

DIEU-MINH LE

Group Art Unit

2184

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE THREE(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 09/27/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-51 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-51 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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**Part III     DETAILED ACTION**

**Drawings**

1.     This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

**Specification**

2.     Claims 1-51 are presented for examination.

**Double Patenting Rejections**

3.     Claim 1-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. patent 6,167,520, claims 1-68 of U.S. Patent 6,092,194 and claims 1-44 of U.S. patent 6,154,844. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter contains obvious modifications to previous claims 1-8 of U.S. patent 6,167,520, claims 1-68 of U.S. Patent 6,092,194 and claims 1-44 of U.S. patent 6,154,844.

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As to claims 1, 12, 22, 33, 48, and 50 these claims include limitations of: monitoring the operating system, interrupting processing of the request, comparing information pertaining to the Downloadable against a predetermined security policy, and performing a responsive action based on the comparison, which already included in claims 1-8 of U.S. patent 6,167,520, claims 1-68 of U.S. Patent 6,092,194 and claims 1-44 of U.S. patent 6,154,844. It is well settled that the omission of an element and its function [i.e., linking by the inspector or preventing execution of the Downloadable by the client] is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136, USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Therefore, omitting various elements from the previous claimed subject matter would have been obvious to one of ordinary skill in the art in this case since the remaining elements do in fact perform the same functions as before. Elimination/Changing of an element or its function will not serve as a basis for patentability.

4. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37

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C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

**Allowable Subject Matter**

9. Claims 1-51 are allowable over the prior art of record. However, these claims are still subject to the rejection discussed in paragraph 3 above.

**Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5. A shortened statutory period for response to this action is set to expired THREE (3) months, ZERO days from the date of this letter. Failure to respond within the period for response will cause the application to be abandoned. 35 U.S.C. 133.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dieu-Minh Le whose telephone number is (703) 305-9408. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel, can

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be reached on (703)305-9713. The fax phone number for this Group is (703)746-7240.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 746-7239, (for formal communications  
intended for entry)

**Or:**

(703) 746-7240 (for informal or draft  
communications, please label "PROPOSED" or  
"DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).



**DIEU-MINH THAI LE  
PRIMARY EXAMINER  
ART UNIT 2184**

DML  
March 06, 2002